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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,526	02/12/2004	Chun-Yung Huang	3624-0154P	4154
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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,526

Applicant(s)

HUANG, CHUN-YUNG

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the assembling step" in lines 6 and 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the welding step" in lines 7 and 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the assembling step" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the welding step" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Su (USPN 5713800).

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Regarding claim 1, Su discloses a golf club head comprising a body including a recess in a front side thereof; and a striking plate including a striking face on a front side thereof for striking a golf ball, a plurality of positioning protrusions projecting from a perimeter of the striking plate; wherein when the striking plate is inserted into the recess of the body, said plurality of positioning protrusions plastically deform and engage with an inner perimeter delimiting the recess (See Figure 2). It is submitted that Su meet the process limitations of the claim being that the final product is the same (See MPEP 2113).

Regarding claim 2, Su discloses the recess to include a stepped portion for supporting the striking plate (See Figure 2).

Regarding claim 5, Su discloses each of the plurality of positioning protrusions having an inclined face on a bottom side thereof for guiding the plurality of positioning protrusions into the recess of the body (See Figure 3).

Regarding claim 6, Su shows the striking face and the plurality of protrusions defining a space for receiving filler (See Figure 2).

Regarding claim 7, Su shows each of the plurality of positioning protrusions being parallelepiped (See Figure 2).

Regarding claims 8 and 9, the limitation claimed is a product by process claim, therefore, it is submitted that Su meet the limitation of the claim being that the final product is the same (See MPEP 2113).

2. Claims 10, 11, and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lo (USPN 5303922).

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Regarding claim 10, Lo discloses a golf club head comprising a body including a recess in a front side thereof, a plurality of positioning protrusions projecting from an inner perimeter delimiting the recess, and a striking plate including a striking face on a front side thereof for striking a golf ball; wherein when the striking plate is inserted into the recess of the body, said plurality of positioning protrusions plastically deform and engage with a perimeter of the striking plate (See Figure 1). It is submitted that Lo meet the process limitations of the claim being that the final product is the same (See MPEP 2113).

Regarding claim 11, Lo discloses the recess including a stepped portion for supporting the striking plate (See Figure 1).

Regarding claim 14, Lo would inherently disclose a space between the striking plate and the protrusions being that there is a tolerance between the two elements for fitting.

Regarding claim 15, Lo shows each of the plurality of positioning protrusions being parallelepiped (See Figure 1).

Regarding claims 16 and 17, the limitation claimed is a product by process claim, therefore, it is submitted that Lo meet the limitation of the claim being that the final product is the same (See MPEP 2113).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su (USPN 5713800).

Regarding claims 3 and 4, Su does not explicitly disclose the dimensions of the protrusion, but one having ordinary skill in the art would have drawn from Su that the dimension of the protrusion may be of any length or width so long as the invention is achieved. Therefore, one having ordinary skill in the art would have found it obvious to have protrusions of any dimension in order to hold the striking plate in place.

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (USPN 5303922).

Regarding claims 12 and 13, Lo does not explicitly disclose the length and width of the protrusion, but one having ordinary skill in the art would have drawn from Lo that the dimension of the protrusion may be of any length or width so long as the invention is achieved. Therefore, one having ordinary skill in the art would have found it obvious to have protrusions of any length and width in order to hold the striking plate in place.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (USPN 5303922) in view of Cheng (USPN 5967903).

Regarding claim 18, Lo discloses a golf club head comprising a body including a recess in a front side thereof, a plurality of positioning protrusions projecting from an inner perimeter delimiting the recess, and a striking plate including a striking face on a front side thereof for striking a golf ball; wherein when the striking plate is inserted into the recess of the body, said plurality of positioning protrusions plastically deform and

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engage with a perimeter of the striking plate (See Figure 1). Lo would inherently disclose a space between the striking plate and the protrusions being that there is a tolerance between the two elements for fitting. Lo does not disclose a brazing material. Cheng discloses a club head having a striking face connected to the club head body by means of brazing, welding, adhesive, screws, etc. (See Column 3, lines 27 through 30). The brazing process for attaching the face to the body would inherently require a brazing material. Therefore, one having ordinary skill in the art would have found it obvious to use a brazing material within the gap, as taught by Cheng, as an attachment for connecting the striking face to the body of the club head.

Response to Arguments

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700